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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,162	07/20/2000	Thomas H. Baum	249-Div.	2598

7590

09/15/2004

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EXAMINER

MARKHAM, WESLEY D

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/620,162

Applicant(s)

BAUM ET AL.

Examiner

Wesley D Markham

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Office Action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-5,7-17,19,21 and 28-30.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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**DETAILED ACTION / ADVISORY ACTION**

***Response to Amendment***

1. Acknowledgement is made of the after-final amendment filed by the applicant on 8/23/2004, in which the applicant proposed to amend independent Claim 1 and Claim 28. However, this amendment has not been entered because it raises new issues that would require further searching and consideration on the part of the examiner. Specifically, the applicant proposed to amend independent Claim 1 to require that the manganate material have a Curie temperature between 273 K and 324 K (as opposed to between 273 K and 334 K, as previously recited), which significantly changes the scope of the claims of the instant application. This limitation in conjunction with independent Claim 1 may be sufficient to overcome the art of record, as Jin teaches that the material should have a Curie temperature  $\geq 330$  K (i.e., a value outside of the applicant's claimed range), but inclusion of the newly proposed range of Curie temperatures would require further searching and consideration on the part of the examiner (i.e., to determine whether such a range of temperatures has support in the applicant's originally filed specification, and to determine whether or not such a range is disclosed / reasonably suggested by the prior art).

***Response to Arguments***

2. Applicant's arguments filed on 8/23/2004 have been fully considered but they are not persuasive. First, the majority of the applicant's arguments are drawn to the claims

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as proposed in the amendment of 8/23/2004 (i.e., requiring the narrower range of Curie temperatures). Since this amendment has not been entered for the reasons set forth above in paragraph 1, the associated arguments are moot. Regarding dependent Claim 5, the applicant does argue that Biagini is non-analogous art, as it teaches a ternary catalytic system for the polymerization of monomers. In response to applicant's argument that Biagini is non-analogous art, and as noted by the applicant, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the applicant and Biagini are concerned with the utilization of various Lewis base complexes of metals, such as metal pivalates and metal  $\beta$ -diketonates, and as such, are reasonably construed to be within the field of the same endeavor.

3. The examiner notes that, on page 3 of the response filed on 8/23/2004, there is an instruction to "cancel claim 30" (see the top of the page). However, Claim 30 is listed as (Previously Presented) on page 6 of the response, which is contrary to the applicant's instructions.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (571)

272-1422. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

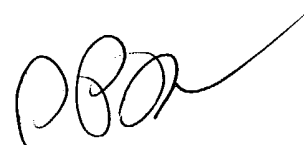
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WDM

Wesley D Markham  
Examiner  
Art Unit 1762



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